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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/487,417	01/20/2000	Magda Mourad	SE9-99-020	3136

23334 7590 05/15/2003

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EXAMINER

REAGAN, JAMES A

ART UNIT PAPER NUMBER

3621

DATE MAILED: 05/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/487,417

Applicant(s)

MOURAD ET AL. *ES*

Examiner

James A. Reagan

Art Unit

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-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondenc address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in response to the CPA filed 28 February 2003 and the amendment also filed on 28 February 2003.
2. Claims 1, 7, 19, and 21 have been amended (paper #12).
3. Claims 1-24 have been examined.
4. The rejections of claims 1-24 have been updated to reflect the changes in the limitations.

### **Previous Claim Rejections - 35 USC § 112**

5. Claims 1, 7, 19 and 21 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has since removed the troublesome claim language, and the rejection is hereby withdrawn. The examiner thanks the applicant for correcting this minor deficiency.

### **Specification**

6. The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code on page 8. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

**Claim Rejections - 35 USC § 103**

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-3, 5, 7-16 and 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon '911 in view of Dillon '467, and further in view of Gennaro et al. (US 5,937,066 A).

**Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

**Claims 1, 7, 13, 15, 16 and 21-23:**

Dillon '911 discloses using a symmetrical encryption scheme, such as DES I.e., public and private key infrastructure (PKI) in column 5, lines 23-37. Dillon '911 also discloses an electronic document distribution system such that Applicants' step of encrypting the data reads on the document of Dillon '911 in column 6, lines 57-58, Applicants' first decrypting key reads on the key seed and Applicants' second encrypting key reads on the Dillon '911 teaching of encrypting the announcement

message in column 6, lines 44-48 and lines 57-58. Applicants' promotional metadata reads on the catalog. Dillon '911 does not specifically disclose a double-encryption technique where a first encryption key is encrypted using a second encryption key. However, the practice of double encryption is widespread in the encryption arts as is shown by Gennaro in the abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dillon '911 with Gennaro because encrypting a key provides a second level of document protection.

Dillon '911/Gennaro do not specifically disclose the details of broadcasting using multiple channels. However, Dillon '467 teaches a system and method for multicasting multimedia content such that Applicants' step of broadcasting at least part of the encrypted data over a second channel reads on the promotional material received from the back end or multicast network (column 16, lines 53-67) and Applicants' step of transferring the decrypting key reads on column 15, lines 59 – 62. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the detailed broadcasting method taught by Dillon '467 with the document distribution system taught by Dillon '911/Gennaro as the purpose, distribution of electronic material, of both systems is the same.

**Claim 2:**

Both Dillon '911 and Dillon '467 teach scheduling the promotional data.

**Claim 3:**

Both Dillon '911 and '467 teach the use of a web browser within their respective receivers.

**Claims 5, 12 and 24:**

Dillon '467 teaches utilizing DirecPc™ broadcasting format.

**Claim 8:**

Dillon '467 teaches utilizing a web browser (column 1, lines 18-25).

**Claims 9-11:**

See Dillon '467, column 18, lines 51 – 60.

**Claim 14:**

See Dillon '467, column 18, lines 15 – 30.

9. Claims 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon '911/Gennaro/Dillon '467 as applied to claim 1 above, and further in view of CableVision (periodical).

**Claims 4 and 6:**

While Dillon '911/Gennaro/Dillon '467 does not specifically teach broadcasting promotional data including a schedule of the broadcast time, CableVision teaches that DirecTv™ and DirecPc™ (DirecPc™ is disclosed in Dillon '467) were combined (DirecDuo™). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the features of DirecTv™, which inherently includes broadcasting promotional data including a schedule of broadcast times, in combination with the teachings of Dillon '911/Gennaro/Dillon '467 as they are all relevant to electronic document distribution.

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- 10.** Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon '911/Gennaro/Dillon '467 as applied to claim 7 above, and further in view of Horstmann (US 6,009,401).

**Claims 17 and 18:**

Dillon '911/Gennaro/Dillon '467 do not disclose the use of a clearinghouse. Horstmann, however, in column 1, lines 38-52 teaches an electronic software distribution system such that Horstmann teaches that a clearinghouse in addition to a publisher (Broadcast center) may be used, or that it could be a publisher (Broadcast center) that also acts as a clearinghouse - as is taught by the Dillon references. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize such an arrangement as disclosed by Horstmann rather than have the broadcast center of the Dillon references perform the billing functions.

**Claim 19:**

Dillon '911 discloses using a symmetrical encryption scheme, such as DES I.e., public and private key infrastructure (PKI) in column 5, lines 23-37. Dillon '911 also discloses an electronic document distribution system such that Applicants' step of encrypting the data reads on the document of Dillon '911 in column 6, lines 57-58, Applicants' first decrypting key reads on the key seed and Applicants' second encrypting key reads on the Dillon '911 teaching of encrypting the announcement message in column 6, lines 44-48 and lines 57-58. Applicants' promotional metadata reads on the catalog. Dillon '911 does not specifically disclose a double-encryption

technique where a first encryption key is encrypted using a second encryption key. However, the practice of double encryption is widespread in the encryption arts as is shown by Gennaro in the abstract. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Dillon '911 with Gennaro because encrypting a key provides a second level of document protection.

Dillon '911/Gennaro do not specifically disclose the details of broadcasting using multiple channels. However, Dillon '467 teaches a system and method for multicasting multimedia content such that Applicants' step of broadcasting at least part of the encrypted data over a second channel reads on the promotional material received from the back end or multicast network (column 16, lines 53 – 67) and Applicants' step of transferring the decrypting key reads on column 15, lines 59 – 62. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the detailed broadcasting method taught by Dillon '467 with the document distribution system taught by Dillon '911/Gennaro as the purpose, distribution of electronic material, of both systems is the same.

Dillon '911/Gennaro/Dillon '467 do not disclose the use of a clearinghouse, Horstmann teaches an electronic software distribution system such that Horstmann teaches that a clearinghouse in addition to a publisher (Broadcast center) may be used, or that it could be a publisher (Broadcast center) that also acts as a clearinghouse - as is taught by the Dillon references. Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize such an



arrangement as disclosed by Horstmann rather than have the broadcast center of the Dillon references perform the billing functions.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dillon '911/Gennaro/Dillon '467/Horstmann as applied to claim 19 above, and further in view of CableVision (periodical).

Dillon '911/Gennaro/Dillon '467/Horstmann do not specifically teach broadcasting promotional data including a schedule of the broadcast time. CableVision teaches that DirecTv™ and DirecPc™ (DirecPc™ is disclosed in Dillon '467) were combined (DirecDuo™). Therefore, it is considered that it would have been obvious to one of ordinary skill in the art at the time of the invention to utilize the features of DirecTv™, which inherently includes broadcasting promotional data including a schedule of broadcast times, in combination with the teachings of both Dillon '911/Gennaro/Dillon '467/Horstmann, as they are all relevant to electronic document distribution.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at (703) 305-9768.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

***Commissioner of Patents and Trademarks***

**Washington, D.C. 20231**

or faxed to:

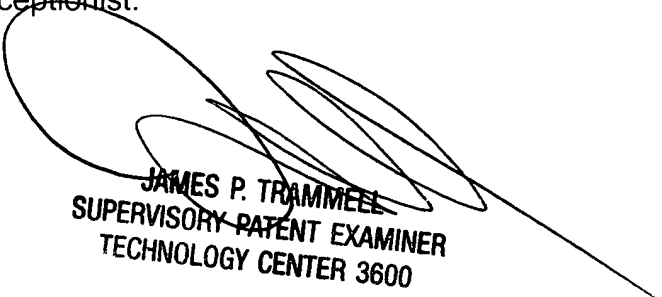
**(703) 305-7687** [Official communications; including

After Final communications labeled "Box AF"]

**(703) 308-1396** [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR  
10 May 2003

  
**JAMES P. TRAMMELL**  
**SUPERVISORY PATENT EXAMINER**  
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